REMARKS

Allowance Followed by Rejection – Arbitrary Decision Issue

It is initially reminded that applicant had completely complied with the final rejection and submitted the amendment 6/29/2006 to only seek allowable claims *without arguments* whatsoever. Applicant presumes that *the response to the final rejection* had been considered *a response to non-final rejection* with confusion under complicated file history.

Applicant respectfully submits that any evidence(s) should be disclosed that led the examiner to a new search so that shock waves could be overcome. Applicant further submits that based upon what clauses in M.P.E.P. did the examiner perform a brand new search in a customary case that if the amendment to the final rejection is directed to only allowable claims without new matter issues whatsoever the examiner has to issue a notice of allowance.

M.P.E.P. 706.07(e)

"...Occasionally, the finality of a rejection may be withdrawn in order to apply a new ground of rejection. ... Although it is permissible to withdraw a final rejection for the purpose of entering *a new ground of rejection*, this practice is to be limited to situations where *a new reference either fully meets at least one claim or meets it except for differences which are shown to be completely obvious.*"

Applicant respectfully requests evidences of *a new ground of rejection* in the amendment 6/29/2006 that sought only allowable claims as response to the final rejection.

Further, applicant respectfully reminds that *the refusal may not be arbitrary or capricious*. M.P.E.P. 1217.07. Applicant claims that his application was discriminated.

M.P.E.P. 706.07(a)

"Under present practice, second or any subsequent actions on the merits shall be final, *except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).*"

Applicant respectfully reminds that (1) *applicant's amendment did not necessitate a new ground of rejection (applicant simply sought allowable claims)*; (2) *information disclosure statement was not filed with the amendment 6/59/2006 to the final rejection.*

Applicant failed to find instance(s) of rejections where an amendment seeking only allowable claims and including no information disclosure statements as response to a final rejection was rejected based upon a new search conducted by the examiner's arbitrary decision. Applicant believes the examiner is subject to proof that the further search was not arbitrary in this case.

Prima Facie Case of Obviousness

To establish a prima facie case of obviousness under 35 U.S.C. §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to on of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Further more, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based upon the applicant's disclosure. A failure to meet any one of these criteria is a failure to establish a prima facie case of obviousness. MPEP §2143

In this obviousness rejection under 35 U.S.C. §103(a) that emerged after amendment that had claimed allowable claims only following the final action, the Examiner newly introduced Park's USP 6,279,824 (hereinafter, "Park") to reject claim 1 which was amended to incorporate allowable claim 5. Basically, the Examiner rejected the allowably amended claim 1 as unpatentable over Chaney's USP 6,035,037 (hereinafter, "Chaney) in view of Park which was newly searched and cited by the Examiner in this rejection after final rejection.

The Examiner states that "Chaney does not disclose outputting a time lapse message when a number of paid digital satellite broadcasting signals is greater than the number of descrambling units." The Examiner further states "Park discloses determining whether a selected channel is scrambled, checking whether a smart card is inserted to determine whether

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the viewer is a charged channel subscriber, and outputting a message requesting the subscriber to insert the smart car if the smart car is not inserted." Then, the Examiner concludes "It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Chaney to include outputting a message requesting a subscriber to insert a smart card if a smart car is not inserted."

Applicant respectfully disagrees that Park discloses the applicant's "outputting a time lapse message when a number of paid digital satellite broadcasting signals is greater than the number of descrambling units." Applicant respectfully submits that there is absolutely nothing in Park to anticipate the applicant's significant comparison and condition of ".. a number of paid digital satellite broadcasting signals is greater than the number of descrambling units."

Further, applicant respectfully indicates that the amended claim 1 has no disclosure about "smart card." Application submits that the Examiner's statement of "inserting a smart card if a smart card is not inserted" has absolutely no connection with the amended claim 1. Simply, there is no description as to "inserting a smart card if a smart card is not inserted" in the amended claim 1.

CONCLUSION

In view of the amendments and remarks made above, it is respectfully submitted that claims 1-4, 6-7 and 9 are in condition for allowance, and such action is respectfully solicited. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to contact the undersigned attorney at the number listed below.

Respectively submitted,

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